IN THE

Supreme Court of the United States

OCTOBER TERM, 1943

No. 248

WILSON

PETITION

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OCTOBER TERM, 1943.

No. 240.

TRUMAN B. WAYNE, *Petitioner,*

v.

WILLIAM W. ROBINSON, JR., and THE TEXAS COMPANY, *Respondents.*

PETITION FOR REHEARING RE PETITION FOR WRIT OF CERTIORARI.

To the Honorable, the Chief Justice, and the Associate Justices of the Supreme Court of the United States:

As we pointed out in the Petition, the Court below, by its decision, has preempted an exclusive jurisdiction dominating the rights of private parties in every state of the Union. As a class, patent applicants everywhere, who chance to become involved in, and win, a three or more party interference in the Patent Office, must submit to suit in the District of Columbia, no matter how far away they reside. In the nature of things no other Court of Appeals will hereafter have an opportunity to consider this question.

No conflict of decisions can develop. Denial of the writ will foreclose the possibility of this Court ever construing a Statute (Sec. 72A, Title 35, U. S. Code) which it has never construed. The decree below will stand as the law of the land unless this Court intercedes in this case.

No Court ought be permitted to preempt an exclusive jurisdiction without review by higher authority. Especially so in a case like this, where that jurisdiction is predicated upon the joinder, as defendant, of one who has nothing to win or lose in the suit, and more especially so where the decision of the Court below indicates a lack of appreciation of, and avoids treatment of, the crucial point involved.

The latter was but the natural result of the character of hearing had in the Court of Appeals. In the first minute (so it seemed) of the hearing in the Court of Appeals, the presiding judge interrupted counsel for appellant (Respondent here) to say (we quote from memory):

> "I have just read the briefs and I cannot understand how so able a District Judge could have gone so far wrong."

From that point, counsel for Appellant and the Presiding Judge had a field day criticizing the decision below. When it came the turn for counsel for Appellee (Petitioner here) to defend the correctness of Judge Bailey's decision, no convincing argument to the Court was possible; it was a case of arguing against the Presiding Judge. Reversal was obvious.

Under such circumstances it is not surprising that the Court of Appeals entirely missed the point of our contentions. While in its opinion it recognized that the real question involved was whether Standard Oil Development Company was an "adverse party", the decision indicates that the Court thought our contention was predicated either upon the fact that Standard was an assignee (rather than the inventor) or that since Standard had not appeared in the case "there was actually no adversity of parties". We

made neither contention. Our contention was that Standard could not be an *adverse* party because the complaint here prayed no relief which would affect the rights of Standard in any way.

Since Standard Oil Development Company (or Cannon, its assignor) had naught to lose and naught to gain in this suit, there could be no adversity of interest between it (Standard) and Defendant Wayne, or plaintiff Texas Company, and hence the unnecessary joinder of Standard as a party defendant could not properly create jurisdiction in the District Court. The failure of Standard to appear simply emphasizes the lack of genuine adversity.

The Court below was mistaken when it said, "The Second Circuit has decided the question favorable to Appellant's contention in the case of *Nachod and U. S. Signal Co.* v. *Automatic Signal Corp.*" The controversial defendant there (Automatic Signal Corporation), owned rights under the *winning* application and, unlike Standard here, stood to lose those rights if the relief prayed for in the suit was granted. There was, in the Nachod case no third party who, like Standard here, had nothing to win or lose.

That Judge Patterson, in his dissent in the Nachod case, conceded "that an assignee or owner of a (winning*) application is an adverse party" is without point, because Standard's assignor had not won the interference but lost it. The only significance of the dissenting opinion in the Nachod case is that since the District Judge here agreed with Judge Patterson that the possession of license rights under the winning application was insufficient to make an exclusive licensee an "adverse party", *a fortiori*, a third party, like Standard, who possess no rights at all under the winning application, could not be an "adverse party" as contemplated by Sec. 72a, Title 35, U. S. Code.

In point of fact both the majority and the dissenting opin-

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*Judge Patterson's concession to which the Court refers applies only to the assignee of "The person who won the interference", 105 Fed. (2d) 984.

ions in the Nachod case recognized that these suits are ordinarily brought in the district "wherein the person who was held to be the prior inventor resides" (l.c., 983) or "in the district whereof the owner of the prevailing application is an inhabitant" (l.c. 984). If the procedure suggested by the majority opinion in the Nachod case, l.c. 983, had been followed in this case, the suit would have been filed not in the District of Columbia, but in the Southern District of Texas where Wayne, who is both the inventor and the owner of the prevailing application, resides.

The decision below therefore rests not only upon a misapprehension of the point involved in this case, but a misinterpretation of the Second Circuit decision upon which in the main the decision below is based. As pointed out in the Petition, the decision below is furthermore inconsistent with the reasoning of other decisions by the same Court involving the statute here in controversy, vide *Coe* v. *Hobart Mfg. Co.*, 102 Fed. (2d) 270, *Tomlinson of High Point* v. *Coe*, 123 Fed. (2d) 65.

This Court has never construed the statute here in controversy (Sec. 72A, Title 35, U. S. Code). Since the decision below is nationwide in scope and effect, the question presented is of such public importance that this Court ought to review the case.

Wherefore it is prayed that the Petition be reconsidered and granted.

Respectfully submitted,

JOHN H. BRUNINGA,
JOHN H. SUTHERLAND,
Counsel for Petitioner.

It is hereby certified that the foregoing Petition for Rehearing is believed to be well founded in law and fact and that it is not interposed for the purpose of delay.

JOHN H. SUTHERLAND.